

REMARKS

INTRODUCTION:

In accordance with the claims listed above, claims 1, 3, 6, 7, 9, 10 and 11 have been amended and new claims 12 and 13 have been added. Support for the amendments and new claims may be found at least at paragraph [0027] and therefore no new matter has been added.

Claims 1-4, 6, 7, and 9-11 are pending in the present application. Claims 1, 3, 6, 9 and 11 are the independent claims. Reconsideration of the claims is respectfully requested.

OBJECTIONS TO THE CLAIMS:

Claims 6-7 and 9-10 are objected to for depending on cancelled claims 5 and 8 respectively. The claims have been amended and thus it is respectfully requested these rejections be withdrawn.

REJECTIONS UNDER 35 U.S.C. §112:

Claims 1-4, 6, 7, 9, and 10 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is traversed and reconsideration is requested.

The claims have been amended to address the rejections and to clarify the recitations. Accordingly, it is respectfully requested these rejections be withdrawn.

REJECTIONS UNDER 35 USC 103:

Claims 1-4, 6, 7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application No. 2003/0023761 by Jeansonne et al. ("Jeansonne") in view of U.S. Application No. 2003/0126492 by Cavin ("Cavin"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeansonne in view of Cavin and further in view of U.S. Publication No. 2005/0032516 by Marchevsky ("Marchevsky"). All rejections are respectfully traversed.

Amended independent claim 1 recites at least the following:

storing in a BIOS memory, beforehand, a network accessing routine determining a wireless accessibility to the wireless service network based on a wireless signal received by the wireless

communication part;

Jeansonne, Cavin, and Marchevsky, taken separately or in combination, fail to suggest or disclose at least all of the above-recited features of independent claim 1. The Office Action notes on page 5, first paragraph that Jeansonne "fails to disclose a BIOS memory storing a network accessing routine determining the wireless accessibility based on the wireless signal received by the wireless communicating part and supplying power directly to the BIOS memory." However, the Office Action looks to modify Jeansonne with Cavin and asserts that Cavin discloses BIOS/firmware (306 & 228) that comprise an 802.11(b) Medium Access Controller (MAC) read as network access routine) which provides interface between the software in the BIOS (306 & 228) and the network card and plays a part in performing wires communication...". Applicants respectfully disagree that Cavin compensates for the deficiencies of Jeansonne for at least the following reasons.

Cavin, at paragraph [0037], describes devices that "may choose to *use the BIOS/firmware layer 306 to make wireless communications* rather than using application software 302 or device drivers 308 within the operating system" (emphasis added). However, "mak[ing] wireless communications" as described in Cavin is clearly different than "a network accessing routine determining a wireless accessibility to the wireless service network based on a wireless signal," as recited above. Further, nothing in Cavin suggests that the MAC perform a network accessing routine. In fact, paragraph [0037] merely states that in an embodiment the MAC may handle the capabilities for measuring and evaluating the Return Signal Strength Indicator (RSSI)) and the PER. Thus, the MAC alone without some further teaching cannot be relied upon to suggest performing a network accessing routine as asserted in the Office Action. Thus, Jeansonne and Cavin fail to suggest or disclose, alone or in combination, all of the above-recited features.

Further, Marchevsky fails to compensate for the asserted deficiencies of Jeansonne and Cavin.

Accordingly, Applicants respectfully submit that claim 1 patentably distinguishes over Jeansonne, Cavin, and Marchevsky, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 3, 6, 9 and 11, with potentially differing scope and breadth, are not suggested or disclosed by Jeansonne, Cavin, and Marchevsky, the rejection should be withdrawn and claims 3 6, 9 and 11 also allowed.

Further, claims 2, 4, 6, 7, 9, and 10, variously depend from independent claims 1 3, 6

and 9, and should be allowable for at least the same reasons as claims 1 3, 6, and 9, as well as for the additional features recited therein.

Amended independent claim 11 recites at least the following:

providing the wireless network accessibility status by audibly
announcing the wireless network accessibility status.

The Office Action fails to set forth if and where Jeansonne, Cavin, and Marchevsky, taken separately or in combination, suggest or disclose at least all of the above-recited features of independent claim 11. Accordingly, Applicants respectfully submit that claim 11 patentably distinguishes over Jeansonne, Cavin, and Marchevsky, and should be allowable.

No Motivation to Combine

Applicant respectfully submits that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, there must be some suggestion or reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP* 2142. Further, there must be a reasonable expectation of success. *MPEP* 2143.02.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify Jeansonne, Cavin and Marchevsky, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the references. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed" slip op. 14, 82 USPQ2d at 1396. Further, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR* at 1396, quoting *In re Kahn*. The reasoning provided in the Office Action states:

"Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Jeansonne et al. with the teachings of Cavin in order to reduce the processing load at the wireless communication module."

Applicant asserts that the cited rationale for combining Jeansonne and Cavin is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* Applicant respectfully submits that this amounts to an improper hindsight reconstruction of the invention.

Furthermore, in *KSR* the Supreme Court held that in determining obviousness, one “must ask whether the improvement is more than the predictable use of prior art elements according to their established functions” slip op. 13, 82 USPQ2d at 1396. The rejection is traversed because as demonstrated above, the claimed features recite more than the predictable use of prior art elements. For example, Cavin describes using the BIOS/firmware layer *to make wireless communications*. Thus, the rejection implicitly asserts that Cavin’s use of the BIOS/firmware layer to make wireless communications establishes the basis for the predictable use of prior art elements according to their established functions. However, as asserted in greater detail above, the recited claim features are clearly different than Cavin’s vague statement regarding making wireless communications and thus Cavin cannot be relied upon for an assertion that the claimed features recite a predictable use of prior art elements.

Moreover, Applicant respectfully asserts that the Office Action fails to establish that Cavin is analogous art. For art to be analogous, it must be in the field of Applicant’s endeavor or reasonably pertinent to the problem to be solved. The rejection relies on the conclusory statement that Cavin is “in the related field of endeavor,” but fails to establish a proper rationale for this statement. To the contrary, Applicant’s assert that Cavin is not reasonably pertinent to the problem that the present application seeks to address because Cavin is directed to increasing data throughput in the presence of intermittent interference, rather than decreasing power consumption.

Accordingly, one skilled in the art would not have had a reason to combine the teachings of Cavin with those of Jeansonne, and the rejection under 103(a) is improper.

NEW CLAIMS:

New claims 12 and 13 are directed to “providing the wireless network accessibility status by audibly announcing the wireless network accessibility status obtained from executing the network accessing routine”. Therefore, it is submitted that claims 12 and 13 patentably distinguish over the prior art.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

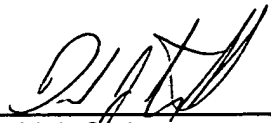
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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